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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,544	06/26/2003	Eduard Hoffmann	4100-316	5283
27799	7590	12/23/2003	EXAMINER	
COHEN, PONTANI, LIEBERMAN & PAVANE 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176			FERGUSON, MARISSA L.	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/606,544

Applicant(s)

HOFFMANN ET AL.

Examiner

Marissa L Ferguson

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14 and 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

DETAILED ACTION

*Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Vrotacoe et al. (US Patent 5,323,702).

Regarding claim 1, Vrotacoe et al. teaches an inner carrier sleeve (40,42) which is expandable outwardly by an application of compressed air (Column 4, Lines 61-68 and Column 5, Lines 1-16), a single rubber layer (60,62) disposed on the inner carrier sleeve and having an outer surface (Figure 3), a covering containing at a distance from the outer surface at least one of compressible elements (62,64) for increasing the relative compressibility K of a single rubber layer and filaments (80,94,102) for increasing the stiffness S of the single rubber layer (Figures 3 and 4).

Regarding claim 2, Vrotacoe et al. teaches compressible elements that are uniformly distributed in a single rubber layer (Column 3, Lines 24-29, Column 10, Lines 4-15, Figure 3 and Figure 7).

Regarding claim 3, Vrotacoe et al. teaches compressible elements that vary in number at least one of an axial direction and a radial direction of the sleeve (Figure 4).

Regarding claim 4, Vrotacoe et al. teaches filaments for increasing stiffness that are distributed uniformly in a single rubber layer (Figure 4).

Regarding claim 5, Vrotacoe et al. teaches filaments for increasing stiffness that vary in density in at least one of an axial direction and a radial direction of the sleeve (Figures 4 and 13).

Regarding claim 6, Vrotacoe et al. teaches compressible elements that are air pockets (Column 3, Lines 24-31).

Regarding claim 7, Vrotacoe et al. teaches compressible elements that are compressible fibers (Column 5, Lines 59-68, Column 6, Lines 1-2 and 42-46, and Column 10, Lines 6-12).

Regarding claim 8, Vrotacoe et al. teaches a single endless rubber layer (Figures 2,3 and Column 5, Lines 29-38).

Regarding claim 15, Vrotacoe et al. teaches compressible elements that are disposed in a single rubber layer so that the relative compressibility  $K$  of the single rubber layer increases continuously from the outer surface to the inner surface and the filaments are disposed in the single rubber layer so that the stiffness  $S$  of the single rubber layer increases continuously from the inner surface to the outer surface (Figure 4).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vrotacoe et al. (US Patent 5,323,702) in view of Hoffman et al. (US Patent 6,484,632).

Vrotacoe et al. teaches the claimed invention, however he does not explicitly disclose a layer containing a joint and/or a gap. Hoffman et al. teaches a rubber cylinder sleeve that contains a joint and/or a gap (Column 4, Lines 28-37) that allows the area to be filled with a material substance. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention taught by Vrotacoe et al. to include a gap/joint as taught by Hoffman et al., since Hoffman et al. uses the joint to dissipate tangential forces during rolling contact in order to provide good printing quality.

3. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vrotacoe et al. (US Patent 5,323,702) in view of Gaworowski et al. (US Patent 6,484,632).

Vrotacoe et al. teaches the claimed invention, however he does not explicitly disclose a layer adhesively bonded to an inner sleeve and wherein the layer is vulcanized. Gaworowski et al teaches a layer adhesively bonded to an inner sleeve and wherein the layer is vulcanized (Column 4, Figures 1 and 2) to ensure proper connection of layers. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention taught by Vrotacoe et al. to include adhesive and vulcanized bonding as taught by Gaworowski et al., since Gaworowski et al. provides bonding in order to reinforce and ensure proper connection between the layers.

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**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa L Ferguson whose telephone number is (703) 305-3194. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other (F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (703) 305-6619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Marissa L Ferguson  
Examiner  
Art Unit 2854

NRJ  
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EDWARD LEFKOWITZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800